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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SILVERIO C. VASQUEZ and JAAN RAAMOT

Appeal 2008-3183
Application 09/811,906
Technology Center 2400

Decided: January 30, 2009

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
STEPHEN C. SIU *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 1-18. We have jurisdiction under 35 U.S.C.
§ 6(b).

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to connecting multiple network sections within physical layer. More particularly, the present invention relates to connecting multiple network sections which may have different transmissions speeds within physical layer protocol. (Spec. 1).

Independent claim 1 is illustrative:

1. A method for communicating information between a plurality of local area network sections having different transmission speeds, the plurality of local area network sections employing a physical layer protocol in which an unsuccessful transmission is communicated to a transmission source prior to completion of the transmission, the method comprising steps of:

- a) receiving, within the physical layer protocol, a packet that is transmitted from a source terminal in a source network section having a source transmission speed to a destination terminal in a destination network section having a destination transmission speed, the destination transmission speed differing from the source transmission speed;

- b) determining the transmission speed for the destination terminal; and

- c) re-transmitting, within the physical layer protocol, the received packet to the destination network section at the destination transmission speed.

THE REFERENCE

The Examiner relies upon the following reference as evidence in support of the obviousness rejection:

| | | |
|---------|--------------|-----------------------|
| Haddock | US 5,560,038 | Sep. 24, 1996 |
| | | (filed Nov. 28, 1995) |

THE REJECTION

1. The Examiner rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) (Spec. 1-4) in view of Haddock and Examiner's Official Notice.

"[T]he examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Therefore, we look to Appellants' Brief to show error in the proffered *prima facie* case.

Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Obviousness under 35 U.S.C. § 103

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, “[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Claims 1-3, 7-11, and 13-18

We consider the Examiner’s rejection of claims 1-3, 7-11, and 13-18. Since Appellants’ arguments have treated these claims as a single group which stand or fall together, we select claim 1 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

APPELLANTS’ CONTENTIONS

1. Appellants contend that the cited references and Official Notice taken by the Examiner fail to teach or suggest “transmitting within the physical layer protocol, the received packet to the destination network section at the destination transmission speed.” (Br. 9).
2. Appellants contend that there is no motivation to combine the teachings of Haddock and the Official Notice with AAPA. (Br. 10).
3. Appellants contend that Haddock teaches away from the claimed invention. (Br. 11).

ISSUES

Have Appellants shown that the Examiner erred in determining that the prior art teaches transmitting “within the physical layer protocol, the received packet to the destination network section at the destination transmission speed?”

Have Appellants shown that the Examiner erred in purportedly failing to provide a motivation to combine the teachings of Haddock and Official Notice with AAPA?

ANALYSIS

As indicated above, Appellants contend that the prior art and Official Notice taken by the Examiner fail to teach or suggest “transmitting within the physical layer protocol, the received packet to the destination network section at the destination transmission speed.” In particular, Appellants contend that the Haddock reference teaches receiving packets and re-transmitting packets at a different speed at the MAC layer or packet layer. (Br. 9).

The Examiner took Official Notice that receiving and transmitting a data packet within the physical layer is known in a computer networking environment at the time the invention was made. (Ans. 5). We note that the Examiner’s taking of Official Notice was not rebutted by Appellants.¹ We

¹ To adequately traverse the Examiner’s finding, Appellants must specifically point out the supposed errors in the Examiner’s action, *which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art*. See 37 C.F.R. 1.111(b). See also MPEP § 2144.03.

also find that Appellants have admitted that the Official Notice taken by the Examiner is prior art. (Br. 8).

Having acknowledged that certain claimed elements are taught by the prior art, Appellants cannot now defeat an obviousness rejection by asserting that the cited prior art fails to teach or suggest these elements. “Valid prior art may be created by the admissions of the parties. . . . [A] statement by an applicant during prosecution identifying certain matter not the work of the inventor as ‘prior art’ is an admission that the matter is prior art.”

Riverwood Int’l Corp. v. R.A. Jones & Co., 324 F.3d 1346, 1354 (Fed. Cir. 2003) (citations omitted); *see also Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A statement in a patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.”); *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (It is a “basic proposition that a statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes”).

In the present case, we find the Examiner’s taking of Official Notice is supported by Appellants’ own admission in the Brief that “the Admitted Art and Examiner’s Official Notice appear to be cumulative, they will be referred to interchangeably hereafter as simply the ‘Admitted Art’” (Br. 8). Thus, Appellants cannot effectively argue that the combined teachings of Haddock, AAPA, and the Examiner’s Official Notice fail to teach the limitation of receiving and transmitting a data packet within the physical layer.

We further note that Appellants merely recited the limitations of claim 11 that differ from claim 1, and do not assert any arguments regarding the separate patentability of claim 11. Accordingly, patentability is urged based on the arguments presented above regarding claim 1, which we do not find to be persuasive.

Appellants further contend that there is no motivation to combine the teachings of Haddock and Official Notice with AAPA.

After considering the evidence before us, it is our view that Appellants' argument does not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner's *prima facie* case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981)(“*The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.*”) (Citations omitted, emphasis added). This reasoning is applicable in the present case.

Appellants contend that the type of data translation operations taught by Haddock is not compatible with data transmission within the physical layer protocol because the Haddock switch is a store and forward device. According to Appellants, store and forward devices such as MAC switches do not switch data at the physical layer. (Br. 10). Appellants further contend that there is no teaching or suggestion that any of the techniques of Haddock are applicable in a physical layer switch.

However, it is our view that Appellants' contentions do not take into account the collective teachings of Haddock, AAPA and the Official Notice. We note that the AAPA and the Official Notice are relied upon by the Examiner as evidence that transmission of data packets at different speeds at the physical layer is well known in the art, and are not meant to suggest a physical or structural combination of Haddock and AAPA.

Appellants further contend that Haddock teaches away from the present invention. We disagree because Haddock does not discourage or disavow the modifications to the AAPA proposed by the Examiner.

"[T]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternative because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ..." *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Thus, we do not find Appellants' arguments that Haddock teaches away from the present invention to be persuasive.

Based on the record before us, we conclude that Appellants did not meet their burden of showing error in the Examiner's *prima facie* case for rejecting claim 1, and claims 2-3, 7-11, and 13-18 which fall therewith. Accordingly, we sustain the Examiner's rejection of claims 1-3, 7-11, and 13-18 as being unpatentable over AAPA, Haddock and Examiner's Official Notice.

Claims 4-6 and 12

We next consider the Examiner's rejection of claims 4-6 and 12 under 35 U.S.C. § 103(a) as being unpatentable over AAPA, Haddock and the Examiner's Official Notice. Since Appellants' arguments have treated these claims as a single group which stand or fall together, we select claim 4 as the representative claim for this group. See 37 C.F.R. § 41.37(c)(1)(vii).

Appellants contend that because Haddock teaches transferring packets between networks having different speeds, the combination of AAPA and Haddock would not allow re-transmitting a single packet before it is received. (Br. 13).

ISSUE

Have Appellants shown that the Examiner erred in determining that the cited prior art teaches "re-transmission of the received packet before the source terminal completes its transmission of the packet?"

ANALYSIS

The Examiner based the *prima facie* case for rejecting claim 4 on the teachings of AAPA. (Ans. 7 and 12). However, it is our view that Appellants' arguments are directed to the teachings of Haddock and do not address the Examiner's findings with respect to AAPA. (Br. 13). Thus, it is our view that Appellants did not meet their burden of rebutting the Examiner's *prima facie* case.

Based on the record before us, we conclude that Appellants failed to meet their burden of showing error in the Examiner's *prima facie* case. Accordingly, we sustain the Examiner's rejection of claim 4 and claims 5-6 and 12 which fall therewith.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude the following:

Appellants have not shown that the Examiner erred in determining that the cited prior art teaches transmitting "within the physical layer protocol, the received packet to the destination network section at the destination transmission speed."

Appellants have not shown that the Examiner erred in failing to provide motivation to combine the teachings of Haddock and Official Notice with AAPA.

Appellants have not shown that the Examiner erred in determining that the cited prior art teaches "re-transmission of the received packet before the source terminal completes its transmission of the packet."

Therefore, claims 1-18 are not patentable.

DECISION

The decision of the Examiner rejecting claims 1-18 under 35 U.S.C. § 103(a) is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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